

Appl. No. 10/667,904
Amdt. dated April 5, 2005
Reply to Office Action of December 8, 2004

PATENT

REMARKS

Claims 1-24 are pending in the application. Applicant amends claims 1, 9, 12, and 22, adds new claim 24, and presents claims 1-24 for consideration and allowance.

Discussion of Rejections Under 35 USC §102(b)

Claims 1, 2, and 6 were rejected under 35 USC §102(b) as allegedly anticipated by U.S. Patent No. 2,029,567 to Hough (hereinafter Hough). The Examiner alleges that Hough discloses every claim element.

In order for a claim to be anticipated by a reference, the reference must describe each and every element as set forth in the claim, either expressly or inherently, in the single prior art reference. Applicant respectfully contends that Hough fails to disclose at least one claimed element from each of claims 1, 2, and 6.

Claim 1 recites an embossing system including a sleeve, stencil and form. The form has "at least one projection that maintains a clearance between a surface of the stencil and a surface of the form distinct from the at least one projection when the form is compressed towards the stencil while positioned in the sleeve." This feature is illustrated in Applicant's Figure 11, where it may be seen that a clearance is maintained between portions of the form distinct from the projection and the stencil when the form is compressed towards the stencil. Hough does not disclose this claimed feature.

As can be seen from Hough Figure 5, the male die 18 has no ability to maintain a clearance between a surface distinct from a projection and the die plate 10. Hough describes the male die 18 and the plate 10 as manufactured from the same initial material, thus the thickness of the male die is the same as the thickness of the plate. Thus, no clearance between the male die and plate are maintained when the male die is compressed towards the plate.

Therefore, Applicant respectfully requests reconsideration and allowance of claim 1, because Hough fails to describe, either expressly or inherently, every claimed feature. Instead, Hough describes an embossing die in which no clearance is maintained between a male die and a corresponding plate.

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Claims 2 and 6 depend from claim 1 and are believed to be allowable at least for the reason that they depend from an allowable base claim. Applicant respectfully requests reconsideration and allowance of claims 2 and 6.

Discussion of Rejections Under 35 USC §103(a)

Claims 3, 5, 8, 9, 12, and 22 were rejected under 35 USC §103(a) as allegedly unpatentable over U.S. Patent No. 5,772,319 to Hirano (hereinafter Hirano) in view of Hough. Claims 4, 10, 11, and 23 were rejected under 35 USC §103(a) as allegedly unpatentable over Hirano in view of Hough and further in view of U.S. Patent No. 4,979,613 to McLaughlin et al. (hereinafter McLaughlin). Claim 7 was rejected under 35 USC §103(a) as allegedly unpatentable over Hough in view of U.S. Patent No. 4,542,691 to Kokrhanek (hereinafter Kokrhanek). Claim 13 was rejected under 35 USC §103(a) as allegedly unpatentable over Hirano in view of Hough and further in view of U.S. Patent No. 5,188,026 to Fuqua et al. (hereinafter Fuqua). Claims 14-21 were rejected under 35 USC §103(a) as allegedly unpatentable over Hirano in view of Hough and further in view of U.S. Patent No. 5,590,910 to Meth (hereinafter Meth).

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be reasonable expectation of success. Finally, the prior art reference, or references when combined, must teach or suggest all of the claim limitations.

Applicant contends that the references, either alone or in combination, do not teach or suggest all claim limitations and that there is no motivation to combine at least some of the references cited by the Examiner.

As noted above in the discussion of rejections under 35 USC §102(b), Hough fails to disclose the feature of "having at least one projection that maintains a clearance between a surface of the stencil and a surface of the form distinct from the at least one projection when the form is compressed towards the stencil while positioned in the sleeve." None of the references

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cited by the Examiner teach or suggest this feature, and none of the references cited by the Examiner teach or suggest modifying the teachings in the references to arrive at the claimed subject matter.

Hirano, in Figure 22, clearly lacks any indication or suggestion of a projection on a form that maintains a clearance between the form and stencil. In Figure 22, the operation of the rollers and the properties of the material X are the only limitations on the distance between the projected and indented die members. The Examiner suggests that Figure 26 shows the clearance. However, Figure 26 of Hirano does not illustrate a condition where the form is compressed towards the stencil and lacks the detail to show any projection that can maintain a clearance between the form and stencil when compressed.

McLaughlin is not directed to embossing systems and thus does not provide any suggestion or motivation to include a projection in a form to maintain a clearance between a form and a stencil. Additionally, there is no motivation to combine the teachings of McLaughlin with Hirano or Hough. McLaughlin is directed to a separable fastening device and there is no suggestion or teaching that indicates that the types of fasteners described in McLaughlin are able to withstand the environment of an embossing system. McLaughlin does not suggest that a form in an embossing system could be fastened to a sleeve by the described fasteners. McLaughlin does not teach nor suggest that the described fasteners have the strength to support a form to a sleeve in an embossing system. Therefore, there is no motivation to combine the teachings of McLaughlin into an embossing system and there is no indication or suggestion that the combination would be successful. Thus, the features of claim 23, which includes the feature of "a layer of static vinyl is located between one of the covers to secure the form or the stencil" are not taught nor suggested by the cited references and there is no suggestion or motivation to combine the teaching so the references to obtain precisely the claimed invention.

Kokrhanek similarly does not teach nor suggest the features claimed in claim 1. None of the figures in Kokrhanek illustrate a projection used to maintain a clearance between the form and stencil in an embossing system.

Fuqua and Meth do not describe embossing systems and thus do not teach nor suggest any relationship between a form and stencil, such as those claimed in claim 1.

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Additionally, there is no motivation to combine the teachings of either Fuqua or Meth with those of Hough or Hirano. The Examiner has not identified why one of ordinary skill in the art would be motivated to pick the specific features identified by the cited references, while ignoring all other descriptions in the references, and combine them in the manner necessary to produce the claimed invention.

Therefore, the cited references, whether alone or in combination, fail to teach or suggest the claimed features. Claims 9, and 22 include features similar to those discussed in relation to claim 1 and are believed to be allowable at least for the same reasons provided in relation to claim 1.

Claims 2-8 and 10-21 depend, either directly or indirectly, from one of claims 1 or 9 and are believed to be allowable at least for the reason that they depend from an allowable base claim. Applicant respectfully requests reconsideration and allowance of claims 2-8 and 10-21.

Discussion of New Claim

Claim 24 is added to the application. No new matter is added in claim 24. Support for claim 24 can be found throughout the specification, as filed. In particular, support for new claim 24 can be found on page 5 lines 3-5.

Claim 24 is believed to be allowable at least for the reason that it depends from an allowable base claim. Additionally, claim 24 is believed to be allowable over the cited references at least for the independent reason that none of the references discuss a vacuum formed plastic form.

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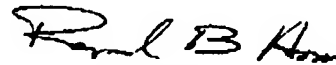
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CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 858-350-6100.

Respectfully submitted,



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